

REMARKS

I. General

Claims 1-35 were pending in the present application, and all of the pending claims are rejected in the current Office Action (mailed February 9, 2005). The outstanding issues raised in the current Office Action are:

- Claims 1-5, 8-22, 24, and 26-35 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,620,205 issued to Sequeira (hereinafter "*Sequeira*") in view of U.S. Patent No. 6,839,680 issued to Liu et al. (hereinafter "*Liu*");
- Claims 6 and 7 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Sequeira* in view of *Liu* and further in view of U.S. Patent No. 6,834,110 issued to Marconcini et al. (hereinafter "*Marconcini*"); and
- Claims 23-25 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Sequeira* in view of *Liu* and further in view of U.S. Patent No. 6,820,133 issued to Grove et al. (hereinafter "*Grove*").

In response, Applicant respectfully traverses the outstanding claim rejections, and requests reconsideration and withdrawal thereof in light of the remarks presented herein.

II. 35 U.S.C. § 103 Rejections over *Sequeira* in view of *Liu*

Claims 1-5, 8-22, 24, and 26-35 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Sequeira* in view of *Liu*. Applicant respectfully traverses these rejections as discussed further below.

To establish a *prima facie* case of obviousness, three basic criteria must be met. See M.P.E.P. § 2143. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of the ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the applied references must teach or suggest all the claim limitations. Without conceding any other criteria, Applicant respectfully asserts that the rejection is improper as there is insufficient motivation to combine the *Sequeira* and *Liu*

references and the applied combination thereof fails to teach or suggest all the claim limitations, as discussed further below.

Independent Claim 1

Independent claim 1 recites:

A method for content delivery, comprising:
requesting a piece of content;
delimiting the piece of content into one or more portions at a source;
associating an identifier with a selected one of the one or more portions
of the content;
sending the identifier to a destination; and
looking up the identifier at the destination and, if the identifier is
found, retrieving the associated portion of content at the destination and, if the
identifier is not found, receiving the associated portion of content from the
source. (Emphasis added).

A. Applied Combination Fails to Teach or Suggest All Elements of Claim 1

The applied combination of *Sequeira* and *Liu* fails to teach or suggest all the above elements of claim 1. For instance, the combination of *Sequeira* and *Liu* fails to teach or suggest “delimiting the piece of content into one or more portions at a source” (emphasis added), as discussed further below. And, the combination of *Sequeira* and *Liu* fails to teach or suggest “looking up the identifier at the destination and, if the identifier is found, retrieving the associated portion of content at the destination and, if the identifier is not found, receiving the associated portion of content from the source”, as discussed further below.

The current Office Action relies upon *Sequeira* as teaching “delimiting the piece of content into one or more portions at a source”. Particularly, the Office Action cites col. 7, lines 21-27 of *Sequeira* as teaching this element of claim 1, *see* page 2 of current Office Action. However, *Sequeira* fails to teach or suggest this element of claim 1. Rather, with reference to FIG. 1 of *Sequeira*, *Sequeira* teaches that a web page may be provided from a web server 104 via a network 100 to a head-end 122, which may partition the web page into partitions corresponding to a display (e.g., for a television set, the web page is partitioned into television screen sized physical partitions), *see* col. 6, lines 21-39 of *Sequeira*. Thus, *Sequeira* does not teach delimiting the piece of content “at a source” (e.g., at the web server

104), but instead performs its partitioning at a destination (head-end 122) after the content has been communicated across network 100. Further, *Liu* fails to teach or suggest delimiting the piece of content into one or more portions at a source. Accordingly, the applied combination of *Sequeira* and *Liu* fails to teach or suggest at least the above element of claim 1.

Further, neither *Sequeira* nor *Liu* teaches or suggests “looking up the identifier at the destination and, if the identifier is found, retrieving the associated portion of content at the destination and, if the identifier is not found, receiving the associated portion of content from the source”. The current Office Action concedes, at page 3 thereof, that *Sequeira* fails to teach or suggest this element of claim 1. However, the Office Action asserts that *Liu* teaches this element. Particularly, the Office Action cites col. 54, lines 15-23 of *Liu* as teaching this element of claim 1. However, col. 54, lines 15-23 of *Liu* makes no mention or suggestion of looking up an identifier. Col. 54, lines 15-23 of *Liu* provides:

Given a document, a search is made for the document in the memory cache. If it is not there, a check is made to see if the document is in the metadata cache 716. If it is, an item representing that information is loaded from the database into the memory cache. If there is no cached item, even on the metadata cache, then the document has not been categorized. It is then categorized, and eventually the categorization will be flushed back to the database. (Flushing updates from the memory cache to the database is done as a background process).

Thus, in the above portion of *Liu* a search is made “for the document” in the memory cache. *Liu* does not teach or suggest using looking up an identifier of a portion of content at a destination. That is, *Liu* does not teach or suggest delimiting the piece of content into one or more portions at a source and associating an identifier with a selected one of the one or more portions of the content, and thus *Liu* does not teach or suggest looking up such an identifier at a destination. Rather, *Liu* merely teaches searching “for the document” in the memory cache and makes no mention of an identifier of a portion of content, as recited by claim 1. Thus, the combination of *Sequeira* and *Liu* fails to teach or suggest this further element of claim 1.

In view of the above, claim 1 is not obvious under 35 U.S.C. § 103(a) over the combination of *Sequeira* and *Liu* because the combination fails to teach or suggest all elements of claim 1.

B. Lack of Motivation to Combine *Sequeira* and *Liu*

Further, the mere fact that references can be combined or modified is not sufficient to establish a prima facie case of obviousness, *see* M.P.E.P. § 2143.01. Rather, it is well settled that the prior art must suggest the desirability of the claimed invention, *see* M.P.E.P. § 2143.01. “There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination” and “[t]hat knowledge can not come from the applicant’s invention itself.” *In re Oetiker*, 977 F.2d 1443, 1447, 24 U.S.P.Q.2d 1443, 1446 (Fed. Cir. 1992). It is insufficient to prove that at the time of the claimed invention, the separate elements of the device were present in the known art. Rather, there must have been some explicit teaching or suggestion in the art to motivate one of even ordinary skill to combine such elements so as to create the same invention. *See Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, 119 F.3d 953, 957, 43 U.S.P.Q.2d 1294 (Fed. Cir. 1997).

Here, no motivation exists for combining the teachings of *Sequeira* and *Liu*. First, these references are non-analogous art that are each attempting to solve a different problem. On one hand, *Sequeira* is concerned with receiving web pages and displaying such web pages on a display, such as a television screen. *Sequeira* explains at col. 2, lines 9-14:

Web pages are designed for displaying on PC monitors, not television sets. Thus, displaying such a page on a television screen generally results in poor image quality and navigating around the page and accessing the hypertext links for a page designed for display on a PC is nearly impossible.

Further, *Sequeira* explains that in a television broadcast environment, bandwidth is too limited for web content and client’s associated with broadcast television are generally low-cost clients with limited processing power (CPUs) and limited memory. Thus, *Sequeira* provides a system in which a head-end device processes Internet content received and partitions the content, wherein each partition corresponds to a display (e.g., a television screen).

On the other hand, *Liu* is directed to Internet profiling, wherein Internet activity of users is tracked over time to develop a profile for each user that describes the interests of such user.

No motivation exists for one of ordinary skill in the art to look to these disparate reference teachings. That is, no motivation exists for one of ordinary skill in the art to look to the Internet profiling technique of *Liu* for a cache solution to be utilized in the system of *Sequeira*.

The current Office Action asserts that it “would have been obvious to one of ordinary skill in the art at the time the invention was made to modify *Sequeira* to utilize cache technology as taught by *Liu* ... in order to create robust, accurate and maintainable performance techniques for content distribution in network communications.” Page 3 of Office Action. The language of the recited motivation is circular in nature, stating that it is obvious to make the modification because it is obvious to achieve the result. Such language is merely a statement that *Sequeira* can be modified, and does not state any desirability for making the modification. Indeed, no motivation exists for looking to the internet profiling technique of *Liu* for a memory cache to include in *Sequeira*. Further, no motivation exists for using the partition identifiers in *Sequeira* for indexing information stored to a cache, particularly considering that the partition identifiers are not taught or suggested as being used in this way by *Sequeira* and *Liu* does not teach or suggest any usage of partition identifiers.

In view of the above, no motivation exists for making the applied combination, and thus the rejection under 35 U.S.C. § 103(a) should be withdrawn.

Independent Claim 22

Independent claim 22 recites:

An apparatus for delivery of content data comprising:
a source having a plurality stored pieces of content, the source for receiving requests for content, delimiting the pieces of content into portions and assigning identifiers to the portions of content; and
a destination coupled to the source via a network, the destination for providing the requests for content, receiving the identifiers from the source in response to the requests and looking up the identifiers in a look-up table at the destination, and wherein when an identifier is found in the table, the destination retrieves an associated portion of content from the table and when the identifier is not found in the table, the destination receives the associated portion of content from the source via the network. (Emphasis added).

A. Applied Combination Fails to Teach or Suggest All Elements of Claim 22

The applied combination of *Sequeira* and *Liu* fails to teach or suggest all the above elements of claim 22. For instance, the combination of *Sequeira* and *Liu* fails to teach or suggest a “source for receiving requests for content, delimiting the pieces of content into portions and assigning identifiers to the portions of content”, as discussed further below. And, the combination of *Sequeira* and *Liu* fails to teach or suggest a “destination for ... looking up the identifiers in a look-up table at the destination, and wherein when an identifier is found in the table, the destination retrieves an associated portion of content from the table and when the identifier is not found in the table, the destination receives the associated portion of content from the source via the network”, as discussed further below.

The current Office Action relies upon *Sequeira* as teaching a “source for receiving requests for content, delimiting the pieces of content into portions and assigning identifiers to the portions of content”. However, as described above with claim 1, *Sequeira* fails to teach or suggest a source for delimiting the pieces of content into portions and assigning identifiers to the portions of content. Rather, *Sequeira* performs its partitioning at a destination (head-end 122) after the content has been communicated across network 100. Further, *Liu* fails to teach or suggest this element of claim 22. Accordingly, the applied combination of *Sequeira* and *Liu* fails to teach or suggest at least the above element of claim 22.

Further, neither *Sequeira* nor *Liu* teaches or suggests a “destination for ... looking up the identifiers in a look-up table at the destination, and wherein when an identifier is found in the table, the destination retrieves an associated portion of content from the table and when the identifier is not found in the table, the destination receives the associated portion of content from the source via the network”. The current Office Action concedes, at page 9 thereof, that *Sequeira* fails to teach or suggest this element of claim 22. However, the Office Action asserts that *Liu* teaches this element. Particularly, the Office Action cites col. 54, lines 15-23 of *Liu* as teaching this element of claim 22. However, as discussed above with claim 1, *Liu* does not teach or suggest this further element. Rather, *Liu* merely teaches searching “for the document” in the memory cache and makes no mention of a look-up table or use of identifiers of an associated portion of content, as recited by claim 22. Thus, the combination of *Sequeira* and *Liu* fails to teach or suggest this further element of claim 22.

In view of the above, claim 22 is not obvious under 35 U.S.C. § 103(a) over the combination of *Sequeira* and *Liu* because the combination fails to teach or suggest all elements of claim 22.

B. Lack of Motivation to Combine *Sequeira* and *Liu*

Further, as discussed above with claim 1, insufficient motivation exists for combining the teaching of the system of *Sequeira* for receiving and displaying web pages via a broadcast television environment with the Internet profiling system of *Liu*. Thus, the rejection of claim 22 under 35 U.S.C. § 103(a) should be withdrawn.

Independent Claim 32

Independent claim 32 recites:

A method for content delivery, comprising:
requesting a piece of content;
delimiting the piece of content into one or more portions at a source;
associating an identifier with a selected one of the one or more portions
of the content; and
determining whether to send the selected one or more portions of
content or the identifier to the destination based on information at the source.
(Emphasis added).

A. Applied Combination Fails to Teach or Suggest All Elements of Claim 32

The applied combination of *Sequeira* and *Liu* fails to teach or suggest all the above elements of claim 32. For instance, the combination of *Sequeira* and *Liu* fails to teach or suggest “delimiting the piece of content into one or more portions at a source” (emphasis added), as discussed above with claim 1. And, the combination of *Sequeira* and *Liu* fails to teach or suggest “determining whether to send the selected one or more portions of content or the identifier to the destination based on information at the source”, as discussed further below.

The current Office Action treats claims 1 and 32 together on pages 2-3 thereof, and in so doing appears to have addressed only the elements of claim 1. That is, the rejection does not address the “determining whether to send the selected one or more portions of content or the identifier to the destination based on information at the source” recited by claim 32.

However, neither *Sequeira* nor *Liu* teach or suggest determining whether to send selected one or more portions of content or an identifier to a destination based on information at the source. For instance, in certain embodiments of the present invention, tag table 112 may be maintained at source 114 for determining whether to send selected one or more portions of content or an identifier to a destination 116. In *Sequeira*, no such determination is made. Rather, a requested web page is sent from web server 104 to head-end 122, which then partitions the web page into display partitions and corresponding partition IDs. No determination is made at the source as to whether to send selected one or more portions of content or an identifier to a destination. Additionally, no portions or identifiers are described in *Liu*, and no such determination is made by *Liu*'s system. Thus, the combination of *Sequeira* and *Liu* fails to teach or suggest this further element of claim 32.

In view of the above, claim 32 is not obvious under 35 U.S.C. § 103(a) over the combination of *Sequeira* and *Liu* because the combination fails to teach or suggest all elements of claim 32.

B. Lack of Motivation to Combine *Sequeira* and *Liu*

Further, as discussed above with claim 1, insufficient motivation exists for combining the teaching of the system of *Sequeira* for receiving and displaying web pages via a broadcast television environment with the Internet profiling system of *Liu*. Thus, the rejection of claim 32 under 35 U.S.C. § 103(a) should be withdrawn.

Dependent Claims

In view of the above, Applicant respectfully submits that independent claims 1, 22, and 32 are patentable over the applied combination of *Sequeira* and *Liu*. Further, each of dependent claims 2-5, 8-21, 24, 26-31, and 33-35 depend either directly or indirectly from one of independent claims 1, 22, and 32, and thus inherit all limitations of the respective independent claim from which they depend. It is respectfully submitted that dependent claims 2-5, 8-21, 24, 26-31, and 33-35 are allowable not only because of their dependency from their respective independent claims for the reasons discussed above, but also in view of their novel claim features (which both narrow the scope of the particular claims and compel a broader interpretation of the respective base claim from which they depend).

As one example, dependent claim 20 depends from claim 1 and further recites “assembling the piece of content at the destination from at least one portion retrieved at the destination and at least one portion received from the source.” The combination of *Sequeira* and *Liu* fails to teach or suggest this further element of claim 20. First, *Sequeira* teaches partitioning web pages into different display screens. The partitions are not assembled at the client. If they were assembled, this would defeat the purpose of *Sequeira*’s partitioning them in the first place (i.e., to generate separate display screens). Further, *Sequeira* does not teach or suggest assembling the content from at least one portion retrieved at the destination and at least one portion received from the source. Rather, all portions are received from the source in *Sequeira*, and are then partitioned into screen displays. Similarly, *Liu* fails to teach or suggest this further limitation. *Liu* does not teach or suggest assembling at least one portion of content retrieved at the destination and at least one portion received from the source. Rather, in *Liu* either the document is found in the memory cache (in which it is retrieved), or it is not. *Liu* does not address assembling a portion retrieved at the destination with a portion received from the source. Thus, this further dependent claim is not taught or suggested by the combination of *Sequeira* and *Liu*.

III. 35 U.S.C. § 103 Rejections over *Sequeira* in view of *Liu* and *Marconcini*

Claims 6 and 7 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Sequeira* in view of *Liu* and further in view of *Marconcini*. Claims 6 and 7 each depend either directly or indirectly from independent claim 1, and thus inherit all limitations of independent claim 1. As discussed above, Applicant respectfully submits that independent claim 1 is patentable over the rejection of record. *Marconcini* fails to correct the above-identified deficiencies in the rejection of claim 1. Thus, it is respectfully submitted that dependent claims 6-7 are allowable not only because of their dependency from independent claim 1 for the reasons discussed above, but also in view of their novel claim features (which both narrow the scope of the particular claims and compel a broader interpretation of claim 1 from which they depend).

IV. 35 U.S.C. § 103 Rejections over *Sequeira* in view of *Liu* and *Grove*

Claims 23-25 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Sequeira* in view of *Liu* and further in view of *Grove*. Claims 23-25 each depend either

directly or indirectly from independent claim 22, and thus inherit all limitations of independent claim 22. As discussed above, Applicant respectfully submits that independent claim 22 is patentable over the rejection of record. *Grove* fails to correct the above-identified deficiencies in the rejection of claim 22. Thus, it is respectfully submitted that dependent claims 23-25 are allowable not only because of their dependency from independent claim 22 for the reasons discussed above, but also in view of their novel claim features (which both narrow the scope of the particular claims and compel a broader interpretation of claim 22 from which they depend).

V. Conclusion

In view of the above, Applicant believes the pending application is in condition for allowance.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 08-2025, under Order No. 10016145-1 from which the undersigned is authorized to draw.

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Date of Deposit: May 9, 2005

Typed Name: Gail L. Miller

Signature: 

Respectfully submitted,

By: 

Jody C. Bishop
Attorney/Agent for Applicant(s)
Reg. No. 44,034
Date: May 9, 2005
Telephone No. (214) 855-8007